

### **REMARKS**

In view of the above amendments and the following remarks, reconsideration of the rejections set forth in the Office Action of December 19, 2004 is respectfully requested.

This amendment has been submitted in view of a telephone conversation with the Examiner on June 17, 2004 regarding the previous Amendment After Final, filed on May 5, 2004. Specifically, because no communication from the USPTO regarding the previous Amendment After Final had been received, and because the non-extendable period for responding to the Final Office Action of December 19, 2003 was set to expire on June 21, 2004, the Applicants' undersigned representative contacted the Examiner by telephone to discuss the status of this Application. During that telephone conversation, the Examiner indicated that an Advisory Action in response to the previous Amendment After Final had been prepared, but had not yet been mailed. Unfortunately, the Examiner was unwilling to provide the Applicants with a copy of the Advisory Action, but was willing to briefly discuss the contents of the Advisory Action due to the impending non-extendable due date.

Specifically, the Examiner indicated that, although most of the outstanding issues set forth in the Final Office Action of December 19, 2004 appeared to be overcome, the Examiner did not enter the previous Amendment After Final because that Amendment did not place the Application in condition for allowance. In particular, the Examiner asserted that the previous Amendment After Final included amendments to claim 15 which appeared to (1) raise new issues requiring further search and consideration, and (2) did not appear to overcome the Examiner's rejection of claim 16 with regard to new matter, as originally set forth in the Final Office Action. This Amendment After Final has been prepared and submitted in view of the Examiner's statements during that telephone conversation.

Firstly, the Examiner is requested to note that dependent claim 15 has now been cancelled. Thus, although the Applicants do not acquiesce to the Examiner's position with regard to amended claim 15 as set forth in the previous Amendment After Final, it is submitted that the Examiner's reasons for refusing entry of the previous Amendment After Final have been overcome. Thus, the Examiner is respectfully requested to enter and consider this Amendment After Final. Secondly,

because the remaining amendments are identical to the amendments originally set forth in the previous Amendment After Final, it is submitted that these amendments place this application in condition for allowance for the reasons originally set forth in the previous Amendment After Final (and reiterated below).

In the Final Office Action, the Examiner rejected claims 15-17, 20, and 21 under 35 USC § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Examiner rejected the claims as including new matter, although the Examiner also appeared to acknowledge that the originally-filed specification teaches the recited subject matter. Specifically, the Examiner noted that paragraph [0016] relates to SiC particles in the volumetric percentages claimed in dependent claim 15, “but only in the context of other unclaimed limitations.” Similarly, the Examiner acknowledged that paragraph [0016] also related to the subject matter recited in dependent claim 16, “but only in the context of other unclaimed limitations.”

The Examiner’s statement “only in the context of other unclaimed limitations” is not entirely clear. In this regard, it is well-known that it is not necessary to claim *every* feature (limitation) disclosed in the specification with respect to a particular embodiment. Furthermore, as acknowledged by the Examiner, paragraph [0016] of the specification discloses a particular embodiment of the invention recited in independent claim 9, and clearly provides support for the subject matter recited in claims 15 and 16. Thus, contrary to the Examiner’s assertion, it is submitted that one of ordinary skill in the art would fully understand that the Applicants had possession of the claimed invention at the time the application was filed. Nonetheless, the Examiner is requested to note that claims 15-21 have now been cancelled. In view of the above, it is respectfully submitted that the Examiner’s rejections under § 112, first paragraph, are no longer applicable.

The Examiner rejected claims 9-21 under 35 USC § 112, second paragraph, as being indefinite. In particular, the Examiner specifically cited two examples of language used in the claims that renders the claims indefinite, and each of these examples will be discussed separately below.

Firstly, the Examiner indicated that it is unclear what is meant by the phrases “providing at least one of a brake disc and a clutch plate” and “a friction member on each of the at least one of a

brake disc and a clutch plate” as recited in independent claims 9 and 18. As discussed with the Examiner during a telephone conversation on December 30, 2003, the phrase “providing at least one of a brake disc and a clutch plate” means “providing a brake disc, a clutch plate, or a brake disc *and* a clutch plate.” Thus, the phrase “each of the at least one of a brake disc and a clutch plate” means “each of the brake disc, the clutch plate, or the brake disc *and* the clutch plate,” depending on which of these elements are present. As explained to the Examiner, the original language was used in an effort to avoid using the term “or” which is often objected to by Examiners as being informal alternative language. However, in view of the Examiner’s expressed preference for the phrase “either a brake disc, a clutch plate, or a disc brake and a clutch plate,” independent claim 9 has now been amended to replace the original phrase with the phrase preferred by the Examiner, and independent claim 18 has been cancelled. However, it is noted that the amendments to claim 9 are not intended to change the scope of the claims.

The Examiner also indicated that it is unclear whether the claimed particle size dimensions as recited in claims 16 and 21 are correct. However, as explained above, claims 16 and 21 have now been cancelled.

With respect to the Examiner’s rejections of claims 9-21 under § 112, second paragraph, independent claim 9 has now been amended, and claims 15-21 have now been cancelled, as explained above. Thus, in view of the above amendments and remarks, it is respectfully submitted that the Examiner’s rejections of claims 9-21 under § 112, second paragraph, have been overcome.

The Examiner has rejected claims 9, 18, and 19 under 35 USC § 102(b) as being anticipated by the Ross reference (USP 5,765,667); and has rejected claims 9 and 18 under 35 USC § 103(a) as being unpatentable over the Burkhard reference (USP 4,180,622). However, the Examiner did not provide any prior art rejections of dependent claims 10-14 which depend from claim 9. Thus, independent claim 9 has now been amended to incorporate the subject matter of dependent claim 10, and claim 10 has been cancelled. In addition, dependent claim 14 has now been amended so as to be placed in independent form including the subject matter of independent claim 9 (amended in order to address the formal matters discussed above), and dependent claims 11-13 have been amended so that they now depend directly from independent claim 9, rather than cancelled claim 10. Finally, as

indicated above, independent claim 18 and the claims that depend therefrom have also been cancelled. Accordingly, it is respectfully submitted that amended independent claims 9 and 14, and the claims that depend therefrom, are now in condition for allowance.

In view of the above amendments and remarks, it is submitted that the present application is now in condition for allowance. However, if the Examiner should have any comments or suggestions to help speed the prosecution of this application, the Examiner is requested to contact the Applicant's undersigned representative.

Respectfully submitted,

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June 21, 2004